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EXAMINER

WONG, DON KITSUN

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JUSTIN PAGE

Appeal 2007-3771
Application 09/557,252
Technology Center 2100

Decided: March 25, 2008

Before JAMES D. THOMAS, HOWARD B. BLANKENSHIP, and
STEPHEN C. SIU, *Administrative Patent Judges*.

SIU, *Administrative Patent Judge*.

ORDER REMANDING TO THE EXAMINER

BACKGROUND

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 19-36. We have jurisdiction under 35 U.S.C. § 6(b). Appellant's invention relates to detecting unauthorized attempts to detect identity information of an individual. An understanding of the

invention can be derived from a reading of exemplary claim 19, reproduced below.

19. A method to detect unauthorized attempts to detect identity information of an individual, to reclaim identity information obtained without authorization, to detect inaccuracies in identity information and to prevent unauthorized access to identity information, the method comprising the steps of:

- a. establishing a database of known private information of one or more individuals, wherein the known private information includes one or more of personal information, financial information, criminal information, and authorized users and storage of such information;
- b. persistently scanning the Internet for stored private information of the one or more individuals stored in one or more other databases, wherein the persistently scanning occurs without requiring initiation through an action of the one or more individuals;
- c. replicating the stored private information of the one or more other databases gathered from the step of persistently scanning to a secure replication database;
- d. establishing indicia of unauthorized storage or use, or inaccuracies, of stored private information;
- e. recording location information of the one or more other databases containing the stored private information;

f. comparing the known private information and the stored private information stored in the secure replication database; and

g. notifying the one or more individuals when the indicia of unauthorized storage or use, or inaccuracies, of stored private information are detected.

PRIOR ART

The following evidence is relied upon by the Examiner in rejecting the appealed claims:

Tibor	US 2004/0234117 A1	Nov. 25, 2004 (filed Apr. 1, 2004)
Smith	US 6,918,038 B1	Jul. 12, 2005 (filed Nov. 16, 1999)
Ellingson	US 6,871,287 B1	Mar. 22, 2005 (filed Jan. 21, 2000)

Claims 19-24, 26-28, and 30-36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tibor and Smith. Claims 25 and 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tibor, Smith and Ellingson.

We have not reached the merits of the instant rejections, beyond finding a threshold issue that obviates a reasoned review of the decision on

appeal. We remand the application to the Examiner in accordance with 37 C.F.R. § 41.50(a).

As set forth above, the Examiner concludes that each of claims 19-36 is unpatentable over Tibor in combination with Smith and/or Ellingson. Tibor was filed in the USPTO on April 1, 2004, and published on November 25, 2004. However, Tibor claims benefit under 35 U.S.C. § 120 as a continuation-in-part of U.S. Patent No. 6,728,397 (“the ‘397 patent”), filed June 18, 1999.

The instant application was filed in the USPTO on April 24, 2000. The instant application filing date thus predates both the publication date and the filing date of Tibor, but is later than the filing date of the ‘397 patent.

Tibor may be accorded an effective filing date of June 18, 1999, to the extent that the parent (the ‘397 patent) provides § 112 support for the invention as required by 35 U.S.C. § 120. *See In re Wertheim*, 646 F.2d 527, 537 (CCPA 1981); *Manual of Patent Examining Procedure* (MPEP) § 706.02(f)(1) (Eighth Ed., Rev. 6, Sept. 2007), “Example 2.”

Appellant asserts that “many of the sections of the Tibor published application cited by the Examiner were modified from their corresponding sections of the ‘397 patent” and that “paragraph [0011] (cited by the Examiner) of the Tibor reference was not in the ‘397 patent . . . paragraph [0012] . . . , . . . paragraph [0030] . . . (and) [0034] of the Tibor reference . . . (include) additional and expanded descriptions . . . (and) the ‘397 patent

makes no mention . . . to a plurality of databases as described in paragraph [0035] of the Tibor reference” (App. Br. 6). Thus, Appellant asserts that the ‘397 patent lacks proper support for cited subject matter in the Tibor published application.

The Examiner cites Tibor (paras. [0011], [0012], [0030], [0032], [0034], and [0035]) as disclosing features of claim 19, with additional paragraphs cited against other claims (Ans. 3-5). However, the Examiner has not shown that the ‘397 patent provides proper support for the cited subject matter in Tibor. Also, the Examiner does not appear to have considered the ‘397 patent in support of the applied rejections of claims 19-36.

Accordingly, it is ORDERED that the application is returned to the Examiner to:

- (1) explain why Tibor rather than the parent (‘397 patent) is used in the instant rejections, if the instant rejections are to be maintained;
- (2) point to where, and explain how, the ‘397 patent provides proper support for each citation relied upon in Tibor, in accordance with MPEP § 706.02(f)(1), if the instant rejections are to be maintained;
- (3) consider rejections based on the ‘397 patent in place of Tibor; and

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(4) take further action as may be appropriate.

REMANDED

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